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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,350	03/12/2004	Edward J. Domanico	9417.6823	6355
44538	7590	11/23/2005		
DANIEL S. POLLEY, P.A. 1215 EAST BROWARD BOULEVARD FORT LAUDERDALE, FL 33301			EXAMINER FRANCIS, FAYE	
			ART UNIT 3725	PAPER NUMBER
DATE MAILED: 11/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,350

Applicant(s)

DOMANICO, EDWARD J.

Examiner

Faye Francis

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 21-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/26/05.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 2, 4, 8, 11-12, 14 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 8, 16 and 18 contains the trademark/trade names HEPA filter and Dacron filter bag respectively. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade names are used to identify/describe the filtering elements and, accordingly, the identification/description is indefinite.

Claims 11, 12 and 14 are indefinite since all that the applicant considers to be encompassed by the phrase "box-like member" cannot be determined.

Claims 2 and 14 recites the limitations "the drum cover" and "said cover" in line 2 and 4 respectively. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deklerow [5,205,497] in view of Perry et al. [5,092,527], hereinafter Perry.

Deklerow discloses in Figs 1-2, a fluorescent lamp collection and disposal system comprising a hazardous material comprising: a housing/drum 11 having a side wall and bottom surface defining an interior area [Fig 1], a cover member 14 having a top surface, a tube member 22, means for breaking the fluorescent lamp [Fig 2], a pipe 23 which corresponds to the claimed hose member, connected at a first end to the cover member as recited in claims 1 and 21. Additionally, Deklerow discloses the tube member is positioned substantially perpendicular with the cover, means for breaking is connected to the drum cover and comprises: a spinner assembly having one or more blades [shaft S and flail 23], a motor assembly M in communication with the spinner

Art Unit: 3725

assembly; and means for powering the motor assembly as recited in claim 3, the hazardous material is a mercury vapor [col 3 line 45] as recited in claim 7.

Deklerow does not disclose a multi stage filtering and vacuum assembly having a plurality of filter members and a vacuum motor creating a negative pressure vacuum within the interior of the housing; wherein a second end of the hose member is connected to the multi-stage filtering assembly such that the hose member is in communication with a first filter member of the multi stage filtering assembly; wherein the negative pressure vacuum causes at least a substantial portion of the hazardous material to be drawn through the hose member and into the multi stage filtering assembly as recited in claim 1. Also, Deklerow does not disclose wherein the plurality of filters include a HEPA filter and an activated carbon filter as recited in claim 4, the housing is a substantially 55 gallon drum as recited in claim 5, the plurality of filters further includes a collection bag and a substantially non-clinging Dacron filter bag; wherein a first stage of filtering is performed by the collection bag and a last stage of filtering is performed by the activated carbon filter as recited in claim 8.

Perry is cited to show desirability, in the relevant art, to provide a fluorescent lamp collection and disposal system with multi stage filtering and vacuum assembly having a plurality of filter members and a vacuum motor 61 creating a negative pressure vacuum within the interior of the housing [col 12 lines 3-64], wherein a second end of the hose member is connected to the multi-stage filtering assembly such that the hose member is in communication with a first filter member of the multi stage filtering assembly [Fig 1], wherein the negative pressure vacuum causes at least a substantial

Art Unit: 3725

portion of the hazardous material to be drawn through the hose member and into the multi stage filtering assembly. Also, Perry shows a HEPA filter 55 and an activated carbon filter 29, the plurality of filters further includes a collection bag 53 and a substantially non-clinging Dacron filter bag 57, wherein a first stage of filtering is performed by the collection bag and a last stage of filtering is performed by the activated carbon filter [Fig 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Deklerow with the multi stage filtering as taught by Perry in order to have a more efficient filtering system.

To the extend if Deklerow fails to disclose the substantially flexible hose, it would have been obvious to make the hose substantially flexible to save storage space. Additionally, at the time of invention it would have been obvious to use a substantially 55-gallon drum and a pressure gauge because they are very common.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deklerow in view of Perry as applied to claims 1-8, 10, 13 and 21 above and further in view of Deklerow [4,655,404], hereinafter Deklerow'404.

Modified device of Deklerow has most of the elements of this claim but for an extension member.

Deklerow'404 teaches that it is conventional to use an extension member 46 secured to a tube member in a fluorescent lamp collection and disposal system to guide the fluorescent lamp. It would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Deklerow'404 to further provide the tube in the

modified device of Deklerow with an extension member in order to better guide the fluorescent lamp into the device.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-8, 10 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/330,814, hereinafter AP'814 In view of Perry.

Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. Claims 1-18 of AP'814 recites a fluorescent lamp collection and disposal system comprising a hazardous material comprising: a housing, a tube member, means for breaking the fluorescent lamp. Additionally, AP'814 recites the tube member is positioned substantially perpendicular with the cover, means for breaking is comprises: a spinner assembly, a motor assembly in communication with the spinner assembly; and means for powering the motor assembly and the hazardous

Art Unit: 3725

material is a mercury vapor. Additionally, AP'814 recites the substantially flexible hose and a substantially 55-gallon drum.

AP'814 does not recite a multi stage filtering and vacuum assembly having a plurality of filter members and a vacuum assembly and an activated carbon filter.

Perry is cited to show desirability, in the relevant art, to provide a fluorescent lamp collection and disposal system with multi stage filtering and vacuum assembly having a plurality of filter members and a vacuum assembly, an activated carbon filter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of AP'814 with the multi stage filtering as taught by Perry in order to have a more efficient filtering system.

8. Claim 9 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending AP'814 In view of Perry and further in view of Deklerow'404.

AP'814 has most of the elements of this claim but for an extension member.

Deklerow'404 teaches that it is conventional to use an extension member secured to a tube member in a fluorescent lamp collection and disposal system to guide the fluorescent lamp. It would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Deklerow'404 to further provide the tube in the AP'814 with an extension member in order to better guide the fluorescent lamp into the device.

This is a provisional obviousness-type double patenting rejection.

Allowable Subject Matter

10. Claims 14-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
11. Claims 11-12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF



Faye Francis